

**REMARKS**

Claims 36, 38-40, 42-44, 46-48, 50-56 and 58-61 are pending in this application.

Claims 36, 42, 43, 44, 50, 51, 52, 58, 59 and 60 are independent.

The claim of priority to 1991 is denied. The denial is respectfully traversed.

The present Application is a Continuation of United States Patent Application Serial Number 09/250,675, now abandoned, which is a Continuation of United States Patent Application Serial Number 08/372,620, now United States Patent Number 5,873,072, which is a Continuation of United States Patent Application Serial Number 07/736,071, now United States Patent Number 5,383,113.

A denial of priority on similar grounds to those asserted in the present application was also asserted in Application Seiral Number 09/541,362, but was overturned on Petition. A copy of the Decision on Petition Under 37 CFR §1.181(a)(3), dated June 13, 2003, in which the claimed priority date of July 25, 1991, has been granted to application serial number 09/541,362, is attached herewith. In view of the prior Decision on Petition, it is respectfully requested that the denial of the claimed priority date in the instant application, as noted on page 2, section A, of the Advisory Action dated June 6, 2003, be reconsidered and withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further

Docket No.: 3350-031G  
File No.: 1158.41324CC7  
Client Ref.: BillPay-G

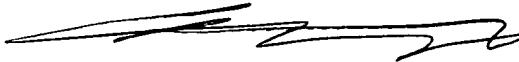
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comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,

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DATE: June 30, 2003  
Enclosure: Copy of Decision on Petition Under 37 CFR §1.181(a)(3) for  
Serial No. 09/541,362



## UNITED STATES PATENT AND TRADEMARK OFFICE

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Appeal Brief 8/12

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DECISION ON  
PETITION UNDER  
37 CFR 1.181(a)(3)

In re Application of: Kight et al.

Application No.: 09/541,362  
Filed: March 31, 2000  
For: BILL PAYMENT SYSTEM  
AND METHOD UTILIZING  
A DRAFT

This Decision is in response to Applicant's Petition under 37 CFR 1.181(a)(3) filed May 15, 2003. Applicant's petition requests the withdrawal of the denial of the claimed priority date of July 25, 1991, as set forth in the final Office Action mailed February 12, 2003, and in the Advisory Action mailed April 28, 2003.

The petition is **GRANTED**.

The instant application was filed on March 31, 2000 and claims priority as a continuation to U.S. Application Serial No. 09/250,675, filed February 16, 1999 (now abandoned); which claims priority as a continuation to U.S. Application Serial No. 08/372,620, filed January 13, 1995 (now U.S. Patent No. 5,873,072); which claims priority as a continuation to U.S. Application Serial No. 07/736,071, filed July 25, 1991 (now U.S. Patent No. 5,383,113).

In the Office Action mailed February 12, 2003, the Examiner denied Applicant's claim for priority to the '071 application filed July 25, 1999. In support of the denial of priority to the '071 application, the Examiner stated that Applicant had failed to comply with one of the conditions for receiving the benefit of an earlier filing date under 35 USC 120. Specifically, the Examiner advanced the position that the instant application is not an application for a patent for an invention which is also disclosed by the '071 application in a manner sufficient to comply with the requirements of the first paragraph of 35 USC 112. The Examiner identified differences between certain figures and text as they appear in each of the disclosures of the instant application and of the '071 application. The Examiner concluded that the differences amounted to the addition of subject matter newly introduced only as of the filing of the '620 application, but lacking sufficient first paragraph support in the '071 application. The Examiner granted Applicant's claim for priority to the '620 application filed January 13, 1995, but denied Applicant's claim for priority to the '071 application filed July 25, 1991.

In the Advisory Action mailed April 28, 2003, the Examiner reiterated and expounded on the position established in the Office Action mailed February 12, 2003.

In this Petition, Applicant alleges that the Examiner has improperly denied the claimed priority to the '071 application, filed July 25, 1991 under 35 USC 120 and 37 CFR 1.78. In support of this allegation, Applicant submits that "even if the Examiner's contention [that the disclosure of the instant application contains subject matter which was not disclosed in the specification of the '071 application] is correct...the Examiner has failed to assert a basis for denying priority on the present application to the filing date of the '071 application" (at page 5); that "in refusing entry of the claimed priority date, the Examiner fails to even assert that any of the claims in the present application are unsupported by the disclosure set forth in the '071 application" (at page 6); that "the Examiner has failed to assert, or let alone provide any evidence, that the invention claimed in the present application was not fully disclosed and enabled by the specification and figures of the '071 application" (at page 8); and that "the Examiner has not alleged that the presently claimed invention could not have been claimed in the '071 application" (at page 9).

35 U.S.C. 120 states in pertinent part:

"An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application" (emphasis added).

A review of the Office Action mailed February 12, 2003, as well as the Advisory Action mailed April 28, 2003 reveals that the Examiner has not identified particular claim language defining an invention lacking sufficient first paragraph support in the disclosure of the '071 application. A further review of the instant claims reveals that sufficient first paragraph support for the instant invention defined by the instant claims is present in the '071 application. Moreover, none of the instant claims relies upon subject matter considered by the Examiner to be new in comparison to the disclosure of the '071 application. Accordingly, the invention of the instant application could have been properly claimed in the '071 application, and shall be afforded the benefit of the filing date of the '071 application, filed July 25, 1991.

Returning to the Office Action mailed February 12, 2003, the Examiner indicated that instant application would be more properly identified as a "continuation-in-part", rather than as a "continuation". The Examiner formed this opinion based on his determination that subject matter which he considered new in the instant application lacked sufficient first paragraph support in the disclosure of the '071 application.

In the Request for Reconsideration filed April 10, 2003, Applicant acknowledged that differences between the disclosures of the instant application and the '071 application exist. Applicant, however, maintained that such differences do not constitute an addition of new matter into the disclosure of the '071 application.

In this Petition, Applicant maintains that the changes made to the disclosure of the instant application do not constitute an addition of new matter, and accordingly, the instant disclosure contains no first paragraph support not present in the disclosure of the '071 application.

MPEP 706.02 states in pertinent part:

The effective filing date of a U.S. application may be determined as follows:

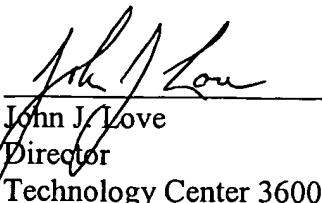
(A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of 35 U.S.C. 120 and 365(c), respectively, have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications.

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application. (emphasis added).

A comparison of the instant disclosure and the '071 disclosure reveals that the instant disclosure and the '071 disclosure are not identical. This point is not in contention. Whether or not the disclosures of the instant application and of the '071 application are identical is not material when considering the validity of a claim for priority under 35 USC 120. An analysis to determine the effective date of the introduction of first paragraph support for new subject matter is taken up only when it is determined that the claims are directed to the new subject matter. Such analysis serves the purpose of establishing a critical reference date required to determine the eligibility of prior art. MPEP 2133.01. A conclusion of such analysis does not serve as the basis for a denial of priority under 35 USC 120. In this case, such an analysis is not necessary, since the instant claims find sufficient first paragraph support in the disclosure of the '071 application—thereby affording the instant invention the benefit to priority under 35 USC 120, regardless of the instant application's status as either a "continuation" or a "continuation-in-part".

The Petition is GRANTED and the objection to Applicant's claim for priority to Application Serial No. 07/736,071, filed July 25, 1991 is hereby vacated.

The application will be forwarded to the Examiner for appropriate action consistent with this Decision.

  
John J. Love  
Director  
Technology Center 3600